

Remarks

The Office Action mailed January 11, 2005, has been received and reviewed. Claims 1-93 are currently pending in the application. Claims 4, 7-9, 12, 14, 15, 44, 59, 69-78, and 86 had been withdrawn from consideration. Claims 1-3, 5, 6, 10, 11, 13, 16-19, 21-37, 42, 45-56, 58, 60, 63-66, 68, 79-85, and 87-93 stand rejected. Claims 20, 38, 40, 41, 43, 57, 61, 62, and 67 have neither been rejected or allowed according to the Examiner's Final Office Action.

By this paper, claims 1-93 have been canceled without prejudice and claims 94-117 have been added. Thus, following amendment by this paper, claims 94-117 are presented for examination. For the reasons set forth below, these claims are believed to be in condition to allowance.

All claims rejected by the Examiner in the aforesaid Office Action have been canceled. Nevertheless, Applicant respectfully submits the following comments related to Examiner's rejection under 35 U.S.C. § 103(a) of claims 1-3, 5, 6, 10, 11, 13, 16-19, 21-37, 42, 45-56, 58, 60, 63-66, 68, 79-85, and 87-93 in the hope that these comments may prove helpful in evaluating claims 94-117.

Applicant has previously cited the standard for a Section 103(a) rejection, as set forth in M.P.E.P. 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on

applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added.)

The Examiner has previously cited Georgetown University Online Payroll Publication (hereinafter "Georgetown"), patents to Mumick (U.S. Patent No. 6,006,207), Risafi (U.S. Patent No. 6,473,500), Kahn (U.S. Patent No. 6,401,079) and several instances of Official Notice, each with an appropriate supporting citation to a reference. The Examiner has discussed how these prior art references disclose payroll advances, electronic transfer of funds, including payroll funds, online access to payroll information, and the use of an automated teller machine to access payroll funds.

Nevertheless, Applicant submits that *automated* access to a payroll advance, as claimed in the amendments submitted by this paper, is not disclosed by any of the cited prior art references, nor is such a combination obvious in light of the prior art.

Applicant submits that the requirement in M.P.E.P. 706.02(j) for "...some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings" is not met by the references cited by the Examiner related to combining a payroll advance with automated electronic access to those advanced payroll funds. Specifically, relating to the first criterion to establish a *prima facie* case of obviousness, M.P.E.P. 2143.01 indicates that the prior art must suggest the desirability of the claimed invention. However, nothing in the prior art suggests the desirability of the present invention, which combines electronic payroll access as was known in the prior art with automated payroll advances, something not heretofore contemplated.

As Applicant has disclosed, automated access to a payroll advance requires several innovations that are not suggested by the prior art, and for which no motivation is evident in the prior art. For example, it is true that 1) Georgetown discloses access to a payroll advance, a request for which might be submitted electronically; and 2) Risafi discloses ATM-style automated access to payroll funds. But combining these two prior art technologies to allow automated access to a payroll advance requires 1) linking an electronically submitted request for a payroll advance to existing payroll processing systems; 2) establishing and tracking criteria by which an automated decision can be made regarding an employee's eligibility to receive a payroll advance; and 3) automated tracking of payroll advances separate from wages earned, so that advances may be deducted from future wages paid. None of these innovations are contemplated or suggested in the cited prior art references.

Nor is the nature of the problem to be solved in any prior art reference the same as that solved by the present invention. Georgetown provides a policy and minimal procedural steps for obtaining a payroll advance, but requires manual review and processing of funds disbursement, even if the request were submitted electronically. Risafi contemplates automated access to payroll—essentially an ATM card to replace a paper paycheck or direct deposit into an employees bank account. But Risafi never discloses or suggests any criteria to be used in evaluating the availability of a payroll advance, nor the tracking of advance payments separate from payroll earnings. Indeed, the problem solved by the present invention is a combination of these ideas. And this combination was never suggested—or enabled—by teachings in the prior art. Specifically, the present invention discloses automated access to payroll advances, without

the inefficiencies of manual review of every request for an advance, creating a formalized system as a service or convenience for those employees who may need payroll advances on a regular basis.

M.P.E.P. 2143.01 provides that “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Because the prior art cited by the Examiner does not suggest the desirability of the combination as claimed by the present invention, a prima facie case of obviousness has not been established. There is no suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Thus, Applicant respectfully submits that claims 94-117 as provided herein are not made obvious by the references cited by the Examiner.

PATENT APPLICATION

Serial No. 09/782,756

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Conclusion

In view of the foregoing, Applicant respectfully submits that claims 94-117 are in condition for immediate allowance. In the event the Examiner finds any remaining impediment to the prompt allowance of any of these claims which could be clarified in a telephone conference, the Examiner is respectfully urged to initiate the same with the Applicant's undersigned attorney.

DATED this 11th day of July, 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'BSB', is written over a horizontal line.

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